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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,552	05/15/2001	Joachim Grupp	Q64134	8317
7590 10/03/2003			EXAMINER	
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC			MISKA, VIT W	
2100 Pennsylvania Avenue, N.W.			ART UNIT	
Washington, DC 20037-3202			PAPER NUMBER	
			2841	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,552

Applicant(s)

GRUPP, JOACHIM

Examiner

Vit W. Miska

Art Unit

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86

USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "flexible body", and the claim also recites "for example, to be secured to a user's wrist" which is the narrower statement of the range/limitation. It is not clear whether the scope of the claim is a flexible body in general, or one which is shaped to be secured to a user's wrist.

3. Further, claims 3 and 5 include the phrase "if required" with respect to the power source, and renders these claims indefinite by failing to specify whether the power source is required or not. In addition the claims lacks antecedent basis for "the power source".

4. Claim 14 lacks antecedent basis for "the flexible display cell".

5. Claim 17 purports to recite a liquid crystal cell, however an electrophoretic material is claimed. Liquid crystal displays are considered distinct from electrophoretic displays and therefore, the claim is indefinite in the terminology employed.

6. Claim 22 lacks antecedent basis for "the reinforcing layer".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 6, 7, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shingo et al. With respect to claim 1, the reference discloses an electronic device secured to a user's wrist for generating and displaying information including flexible body 2, electronic unit 7 generating time information, display cell 7a for displaying the information, the flexible body including an overthickness of material 4d (Fig. 4) forming a cavity 4a for the electronic unit.

8. The overthickness 4d is not specifically referred as providing a rigid receptacle, however, it is apparent to one skilled in the art that the additional thickness provided by this structure will provide additional rigidity to the flexible body 2 and will be rigid in the same manner as applicant's structure containing overthickness 28.

9. With regard to claim 2, an electric power source is not specifically mentioned in the reference. However, one skilled in the art would recognize that an electric power source is necessary for operation of the electronic unit 7 and display 7a.

10. With respect to claims 6 and 7, body 2 is made of a "transparent synthetic resin material" (col. 3, lines 10-11). This plastic material may obviously be selected from any of the well known available materials for this purpose, such as those noted in claim 7.

11. With respect to claims 8 and 10, the electronic unit may obviously include an integrated circuit, the same being conventionally used in timekeeping devices. Although not shown, the electronic unit further will include a control circuit to control display 7a.

12. Claims 1, 2, 5-8, 10, 11, 18, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liautaud. The reference discloses an electronic device (timepiece) including flexible body 11, 23, 24 secured to the user's wrist, electronic unit 12, display cell 13, power source (battery) 90, an overthickness shown in Fig. 3 as the area between portions 45 and 47 forming receptacle 52.

13. The overthickness is not specifically defined in the reference. However, one skilled in the art would recognize that the thickened portion will provide a greater degree of rigidity for this portion of the flexible body, in the same manner as applicant's thickened portion 28.

14. With respect to claim 5, Fig. 9 shows the encapsulation resin embedding the electronic unit.

15. With regard to claims 6 and 7, the material used for casing and band is identified as a "soft plastic material" (col. 6, line 57). The materials noted in claim 7 would constitute well known choices for the plastic molding material.

16. Touch keys 901-93 and push-buttons 20-22 are further disclosed as in claims 18, 19 and 21.

17. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shingo et al or Liautaud as applied to claim 8 above, and further in view of Ransom et al.

A timebase circuit using a quartz resonator divider and counters to provide time information is a standard timekeeping circuit, as shown in Ransom et al. One skilled in

the art would provide such a circuit in either of the timekeeping devices of the two primary references as a conventional timekeeping circuit.

18. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liautaud as applied to claim 11 above, and further in view of Goetzberger. The latter reference teaches charging of battery 6 by means of solar cell 7 in a timepiece. One skilled in the art having both references would thus have a suggestion of providing a rechargeable battery and a solar cell as the power source in Liautaud as a means for providing uninterrupted power to the circuit.

19. Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liautaud and Goetzberger as applied to claim 12 above, and further in view of Takeuchi et al. With respect to claim 13, the Takeuchi et al reference teaches use of a flexible solar cell 43 in a timepiece. One skilled in the art would thus have sufficient suggestion of providing the same in Liautaud as modified by Takeuchi et al as a means for adding flexibility to the entire timepiece structure.

20. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liautaud as applied to claim 1 above, and further in view of Takeuchi et al.

21. The Takeuchi et al patent further discloses a flexible liquid crystal display cell 34 in a timepiece. It would be obvious for one skilled in the art to use such a well known display in Liautaud as a means to add flexibility to the entire structure, as claimed in claim 14. The details set forth in claims 15 and 16 are noted as being conventional in applicant's specification, page 8, line 27 and page 9, line 2ff.

22. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liautaud and Takeuchi et al, as applied to claim 14 above, and further in view of Albert. Electrophoretic displays are well known in electronic devices as shown by the Albert reference. One skilled in the art would be taught to use this conventional display in the Liautaud timepiece as an alternative type of thin digital display.

23. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liautaud as applied to claim 19 above, and further in view of Hepp. The Hepp patent discloses a time measuring instrument with input keys 17 which are checked at regular intervals (multiplexed) by control circuit MUX for actuation by the user. One skilled in the art would be familiar of this type of key input method and would be thus taught to provide a timed key actuation circuit for the keys of Liautaud as a means for conserving battery power.

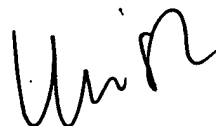
Art Unit: 2841

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vit W. Miska whose telephone number is 703-308-3096. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on 703-308-3121. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4900.

VM
9/19/203


Vit Miska
Primary Examiner